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Technology Center 2100

In re Application of: King et al.)
Application No. 09/551,303) DECISION ON PETITION TO
Attorney Docket No. 04860.P2439) WITHDRAW HOLDING OF
Filed: April 18, 2000) ABANDONMENT UNDER 37 CFR
For: SYSTEM AND METHOD FOR) §1.181
CONTROLLING THE SCREEN DISPLAY)
APPEARANCE FOR A DATA)
PROCESSING SYSTEM)

This is a decision on the request for the notice of abandonment to be withdrawn filed February 17, 2004, which has been treated as a petition under 37 CFR §1.181, requesting the Withdrawal of the Holding of Abandonment of the above-identified application.

The petition is **DISMISSED**.

RECENT CASE HISTORY

- 1) March 10, 2003, a final rejection mailed. Three (3) month shortened statutory period for timely response commences.
- 2) May 8, 2003, an after final amendment and request for reconsideration filed under 37 CFR §1.116.
- 3) June 2, 2003, an advisory action mailed indicating that the request for reconsideration did not place the application in condition for allowance..
- 4) June 10, 2003, a second after final amendment and request for reconsideration filed under 37 CFR §1.116.
- 5) January 29, 2004, notice of abandonment mailed indicating that reply filed June [10] 2003, failed to place the application in condition for allowance and that the period for reply has expired thus the application held abandoned.
- 6) February 17, 2004, the (instant) petition to withdraw the abandonment filed.

BASIS OF OPINION

The relevant portions of the Statutes and Rules are reproduced below. Emphasis is added to draw attention to critical phrases.

§ 1.135 Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. *The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.*

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants or patent owner's reply is *limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116.....*

(c) *Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.*

§ 1.116 Amendments after final action or appeal.

(b) After a final rejection or other final action (§ 1.113), amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. *The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings, will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.*

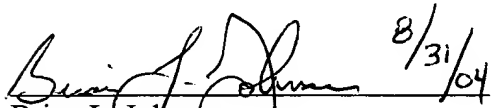
DECISION

Petitioner has provided evidence to the timely response to the final Office action of March 10, 2003 in the filing that includes: a copy of the amendment and response to the final Office action (certificate of mailing dated June 10, 2003); copy of the return postcard (date stamped by OIPE); and a signed and dated transmittal sheet.

As clearly set forth in 37 CFR § 1.135, the admission of, or refusal to admit any amendment after final rejection will not operate to save the application from abandonment [emphasis added]. Irrespective of applicant's timely response of June 10, 2003 to the final office action mailed March 10, 2003, since the response was held to *not* be in compliance with 37 CFR § 1.116 (discussed above) as indicated in the notice of abandonment mailed January 29, 2004, the shortened statutory period for response to the final rejection expired on June 10, 2003, as no extensions of the shortened statutory time period have been received. In addition, note the advisory action mailed June 2, 2004 notified applicant that the proposed changes to the claims submitted on May 13, 2003 was not consistent with that indicated to be allowable by the

Examiner in the final rejection of March 10, 2003. Accordingly, the case remains **abandoned in fact** for failure to timely file a proper reply under §1.116 to the final Office action. The petition is **DISMISSED**.

The holding of abandonment is maintained as proper. The petitioner may wish to revive the application under 37 CFR 1.137. If the petitioner desires further review of this Decision, a request for reconsideration should be filed within two (2) months of the mailing date of this Decision. Telephone inquiries on this decision should be directed to the undersigned at (703) 308-0885.

 8/31/04
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